



<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 59643.00128
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  09/909,039	Filed: July 19, 2001
	First Named Inventor:  Jarmo MAKINEN	
	Art Unit: 2686	
	Examiner: Daniel J. Willie, Jr.	

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.  
☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed

- ☒ Attorney or agent of record.  
Registration No. 58,178

- ☐ Attorney or agent acting under 37 CFR 1.34.  
Reg. No. is acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

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Typed or printed name

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February 15, 2006  
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

- ☒ \*Total of 2 forms are submitted (this form and a Notice of Appeal).



**EXAMINING GROUP 2686  
PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Confirmation No. 8466

Jarmo MAKINEN et al.

Art Unit: 2686

Application No.: 09/909,039

Examiner: Willie J. Daniel, Jr.

Filed: July 19, 2001

Attorney Dkt. No.: 59643.00128

For: CONTROL OF TRANSMISSION POWER IN A RADIO SYSTEM

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

February 15, 2006

This is a Pre-Appeal Brief Request for Review from the final rejection set forth in an Office Action dated November 16, 2005, ("the Office Action") finally rejecting claims 12-36. Applicants submit that there is clear error in the rejection with regard to at least one element of each of the independent claims and that a *prima facie* case for obviousness has not been established with regard to claims 18, 20-22, 25, and 35.

The Office Action rejected claims 12-17, 19, 23-24, 27-34, and 36 under 35 U.S.C. §102(b) as being anticipated by Endo (EP 0847146). Applicants respectfully traverse this rejection for at least the reasons discussed below.

**Clear Error Regarding Interpreting Endo**

It is respectfully submitted that the Office Action's interpretation of Endo's actual errors as the claimed "pseudo errors" as set forth in the Office Action on pp. 2-3, item 2, is clearly erroneous. The detailed explanation of the error of this rejection, provided in the response filed

June 29, 2005, (“the response”) at pp. 18-20 is incorporated herein by reference. Briefly, however, the Office Action appears to incorrectly consider a pseudo error to be the same as an actual error. Applicants respectfully submit that Endo describes observing actual errors and not pseudo errors. Endo fails to disclose or suggest those instances where an error almost occurred, but did not.

As explained by the specification of the present application, at p. 3, ll. 12-24, which are incorporated herein by reference, “pseudo error” refers to a decision-making instant when a bit or symbol error nearly occurred. The specification distinguishes actual and “pseudo” errors, as did the response. This argument was presented in the response, but was not answered in the Office Action.

Applicant is entitled to be his own lexicographer. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). When, as in the present application, an explicit explanation is provided by the applicant for a term, that definition controls interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Accordingly, it is respectfully submitted that the Office Action is required to recognize the meaning of the term “pseudo error” as distinguished from “actual error.”

Because of the difference between “pseudo error” and “actual error,” Endo cannot be understood to decrease or increase transmission power according to pseudo errors. Indeed, Endo does not address pseudo errors whatsoever. As explained in the response at pp. 20-21, each of the independent claims recites elements that include “pseudo errors,” which Endo does not disclose or suggest. Accordingly, it is respectfully submitted that the anticipation rejection of

claims 12-17, 19, 23-24, 27-34, and 36 as well as the obviousness rejections (which will be discussed further below) are clearly erroneous.

### **Failure to Establish a Prima Facie Case of Obviousness**

It is respectfully submitted that the Office Action fails to establish a *prima facie* case of obviousness with regard to claims 18, 20-22, 25, and 35. Claims 18, 20-22, 25, and 35 were rejected as obvious over Endo in view of various references, as explained in detail at pp. 12 et seq. (item 3) of the Office Action. A detailed response to the rejection of those claims is provided at pp. 22-29 of the response, which portion is hereby incorporated by reference.

The Office Action responded to the arguments regarding the obviousness rejections by stating that it is improper to show non-obviousness by attacking references individually, where the rejections are based on combinations of references, citing In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) and In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants respectfully submit that the Office Action's reliance on Keller and Merck is misplaced. Applicants' response follows the pattern laid out by the Federal Circuit: identify the deficiencies of the primary reference, and determine whether the secondary reference remedies those deficiencies. In re Rijckaert, 28 USPQ2d 1955, 1956-7 (Fed. Cir. 1993). Additionally, as the Federal Circuit has explained, Applicants are not required to show nonobviousness until a *prima facie* case for obviousness has been established. Rijckaert at 1957. Additionally, Applicants have not addressed a reference in isolation, like the applicant in Merck, nor have Applicants provided an affidavit regarding a solitary reference like the applicant in Keller. Accordingly, Applicants' argument complies with the law as set forth by the Federal Circuit.

Indeed, Applicants respectfully submit that the deficiency of the primary reference, Endo, as described above is not remedied by any of the secondary references provided, because they do

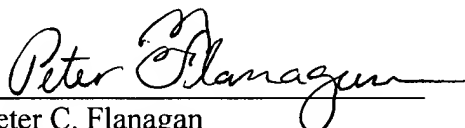
not provide the teaching of “pseudo errors” required to modify Endo into something that the presently pending claims would read on.

Accordingly, it is respectfully submitted that a *prima facie* case for obviousness has not yet been established. Additionally, the combination of references fails to teach or suggest all of the elements of the claims.

### **Conclusion**

For all of the above-noted reasons, it is respectfully requested that the pending rejections be withdrawn, because Endo and the other cited references fail to teach the “pseudo errors” called for in various elements of all of the presently pending claims. It is respectfully submitted that a failure to distinguish between “pseudo errors” and actual errors constitutes clear error, and that this clear error negates the *prima facie* case of obviousness with respect to claims 18, 20-22, 25, and 35. Therefore, it is respectfully requested that all of the pending claims be allowed, and that this application be passed to issue.

Respectfully submitted,

  
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